

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Karri OSARA et al.

Confirmation No.: 7912

Patent No.: 7,504,009

Group Art Unit: 1795

Serial No.: 10/533,798

Filed: May 4, 2005

Examiner: Bell, Bruce F.

For: METHOD FOR THE FORMATION OF A GOOD CONTACT SURFACE ON AN
ALUMINIUM SUPPORT BAR AND SUPPORT BAR

PETITION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

UNDER 37 C.F.R. § 1.705(d)

Mail Stop **Petitions**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition for reconsideration of the Determination of Patent Term Adjustment under 35 U.S.C. §154(b) for U.S. Patent No. 7,504,009.

Applicants have previously submitted a Petition For Reconsideration Of Patent Term Adjustment Under 37 C.F.R. § 1.705(b) for this case on November 14, 2008. The Office responded with a decision on February 12, 2009, indicating that the decision was being held in abeyance until the patent issues.

The above-identified application has now issued as U.S. Patent No. 7,504,009 and applicants resubmit the Petition For Reconsideration Of Patent Term Adjustment now under 37 C.F.R. §1.705(d). Applicants submit herewith 1) a copy of the Office's decision on the petition filed under 37 C.F.R. §1.705(b) and 2) a statement of the facts. Applicants believe that no payment is required, since the statement of facts presented herein are substantially the same as those previously presented on November 14, 2009.

STATEMENT OF FACTS

On May 4, 2005, the application which issued as U.S. Patent No. 7,504,009 was filed in the U.S. Patent & Trademark Office (USPTO), thus qualifying for Patent Term Adjustment (PTA) under 35 U.S.C. §154. The instant application is not currently subject to a terminal disclaimer.

On March 17, 2009, the USPTO issued the above-referenced patent indicating that the Patent Term Adjustment Under 35 U.S.C. § 154(b) was **477** days.

We have reviewed the prosecution history of the above-referenced application and confirm that the term calculation by the USPTO is 477 days according to **35 U.S.C. § 154(b)(1)(A)** (i.e., 506 days delayed by USPTO during prosecution – 29 days delayed by applicants). However, this term adjustment fails to consider the delay by the USPTO in issuing the patent within three years from the filing date **35 U.S.C. § 154(b)(1)(B)**.

In relevant part, 35 U.S.C. § 154 states (emphasis added):

(b)ADJUSTMENT OF PATENT TERM.—

(1)PATENT TERM GUARANTEES.—

(A)GUARANTEE OF PROMPT PATENT AND TRADEMARK OFFICE RESPONSES.—
Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to—

(i)provide at least one of the notifications under section 132 of this title or a notice of allowance under section 151 of this title **not later than 14 months after**—

(l)the date on which an application was filed under section 111(a) of this title; or

* * *

(B)GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY.— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the **failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date** of the application in the United States, not including—

* * *

Applicants submit that the correct patent term calculation under 35 U.S.C.

§ 154 for the above-referenced patent is **600 days**. Applicants' calculation of PTA properly includes:

1. 506 days of delay by the USPTO during prosecution (503 days of delay in issuing the first Office Action within 14 months of the filing date and 3 days of delay in issuing the application within 4 months of paying the issue fee);
2. 123 days of delay by the USPTO in issuing the patent beyond 3-years-from-filing-date to the filing of a Request for Continued Examination (from May 4, 2008 to September 4, 2008); and
3. An adjustment of 29 days of delay by the applicant during prosecution.

This calculation does not include any overlapping days. Therefore, based on the proper interpretation of 35 U.S.C. § 154, applicants are entitled to **600 days** of PTA (506 days + 123 days – 29 days).

Applicant's view is supported by recent case law interpreting 35 U.S.C. § 154. Wyeth, et al. v. Jon W. Dudas, 580 F. Supp. 2d. 138 (D.D.C. 2008). In Wyeth the federal District Court for the District of Columbia granted summary judgment in favor of Wyeth, determining that the U.S. Patent and Trademark Office had misconstrued 35 U.S.C. § 154(b)(2)(A). As a result, the Office had denied Wyeth a portion of patent term

to which it was entitled under the law. Wyeth held, and the court agreed, that the proper PTA includes USPTO delays before the 3-years-from-filing date plus all delays between the 3-years-from-filing date and the issue date, less applicant delays; and, that this would not constitute impermissible “double-counting” of delay periods.

Applicants respectfully assert that the USPTO’s Determination of PTA has been improperly calculated and respectfully request adjustment of the 477 days of PTA to **600 days**.

CONCLUSION

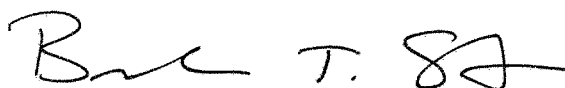
In considering the evidence as detailed in Image File Wrapper and Transaction History of the Patent Application Information Retrieval (PAIR) system, Applicants respectfully request reconsideration of the Patent Term Adjustment and request that the patent which issues from the instant application be accorded the correct Patent Term Adjustment.

AUTHORIZATION

Applicants believe that no payment is required, since the statement of facts presented herein are substantially the same as those previously presented on November 14, 2009. However, in the event that the Commissioner requires payment for this submission, the Commissioner is hereby authorized to charge any fees which may be required for consideration of this Petition to Deposit Account No. **504827**, Order No. 1004350.123US.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. **504827**, Order No. 1004350.123US.

Respectfully submitted,
Locke Lord Bissell & Liddell LLP



Dated: May 11, 2009

By: _____

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